



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,155	02/04/2002	Yoshinobu Shiraiwa	03500.016155	9159
5514	7590	12/13/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				HUNTSINGER, PETER K
		ART UNIT		PAPER NUMBER
		2625		

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/061,155	SHIRAIWA, YOSHINOBU
	<b>Examiner</b>	<b>Art Unit</b>
	Peter K. Huntsinger	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 September 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 51-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 51-58 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/06, 11/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 51-58 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 57 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 57 states "a computer program product stored on a computer-readable memory medium." The claim should be amended to "a computer-readable memory medium storing a computer program product."

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 51, 52, 54, 55, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. Patent 6,930,717, and further in view of Kamimura Patent 6,559,963.

Referring to claims 51, 54, 57, and 58, Kobayashi et al. disclose an image pickup apparatus comprising: an image pickup unit for obtaining a digital image (CCD image sensor 35 of Fig. 7, col. 7, lines 38-44); an interface for connecting to a storage medium which stores the digital image obtained by said image pickup unit (col. 7, lines 54-67); a reproducing unit for reading out the digital image stored in the storage medium via said interface and causing a display apparatus to display the read-out image (col. 7, lines 54-67); an operation unit for effecting a changeover operation of an image to be displayed on the display apparatus (Fig. 5b, col. 4-5, lines 61-67, 1-7); a designating unit for designating the image displayed on the display apparatus as a print subject for a printer communicating with said image pickup apparatus (control panel 56 of Fig. 7, col. 8, lines 26-29); a display control unit for causing the display apparatus to display a print setting screen, in accordance with a first designation provided to said designation unit (col. 9, lines 21-25) when said image pickup apparatus is in a state in which an image to be displayed on the display apparatus is changeable in accordance with an operation of said operation unit (col. 4-5, lines 61-67, 1-7); and a printing control unit for instructing the printer to print the image displayed by the display apparatus, in response to a second designation provided to said designation unit successively to the first designation (col. 4, lines 58-60). Kobayashi et al. do not disclose expressly an external printer and determining whether the external printer is communicating with the camera prior to printing. Kamimura discloses an external printer (main body 14 of Fig. 1, col. 4, lines 15-20); and determining if the image pickup apparatus is communicating with the external printer prior to printing (S43 of Fig. 10, col. 10, lines 55-65). Kobayashi et al.

and Kamimura are combinable because they are from the same field of digital cameras connected to a printer. At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize an external printer and determine if the external printer is communicating with the camera prior to printing. The motivation for doing so would have been to print images with better quality than capable by an internal printer and to only attempt printing when the camera is capable of transmitting pictures. Therefore, it would have been obvious to combine Kamimura with Kobayashi et al. to obtain the invention as specified in claims 51, 54, 57, and 58.

Referring to claims 52 and 55, Kobayashi et al. disclose wherein the print setting screen is arranged so as to display a menu for instructing execution of a printing operation, and another menu, the menu for instructing execution of the printing operation being selected as a default menu in the displayed print setting screen (col. 4-5, lines 61-67, 1-7)

5. Claims 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. Patent 6,930,717 and Kamimura Patent 6,559,963, and further in view of Hatakenaka et al. Patent 6,563,542.

Referring to claim 53 and 56, Kobayashi et al. disclose a print setting screen but do not disclose expressly a selection item of cancellation. Hatakenaka et al. disclose a selection item of cancellation (END of Fig. 4A, col. 6, lines 38-42). Kobayashi et al. and Hatakenaka et al. are combinable because they are from the same field of digital cameras connected to a printer. At the time of the invention, it would have obvious to a

person of ordinary skill in the art to provide a cancellation item in a menu. The motivation for doing so would have been to allow the user to stop an unwanted action. Therefore, it would have been obvious to combine Hatakenaka et al. with Kobayashi et al. and Kamimura to obtain the invention as specified in claims 53 and 56.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH



KWilliams  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER